15

Office - Supreme Court, U. S.
FILED
FEB 11 1946
CHARLES ELMORE CROPLEY
CLERK

IN THE

Supreme Court of the United States

OCTOBER TERM, 1945.

No. 771

STANLEY G. KLUMB,
Petitioner,

vs.

JOHN ROACH AND EDWIN B. H. TOWER, JR.,
Respondents.

BRIEF FOR RESPONDENTS IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI.

EDWIN B. H. TOWER, JR.,
Attorney for Respondents.

THE BLAKELY-WARREN PRINTING COMPANY, 310 WEST JACKSON, CHICAGO

IN THE

Supreme Court of the United States

OCTOBER TERM, 1945.

No. 771.

STANLEY G. KLUMB,

Petitioner,

vs.

JOHN ROACH AND EDWIN B. H. TOWER, JR.,

Respondents.

BRIEF FOR RESPONDENTS IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI.

I. The Court of Appeals, Seventh Circuit, decided October 26, 1945, on the appeal in the suit of *Klumb* v. *Roach and Tower*, 151 F. 2d 374, 67 USPQ 158, that the District Court never acquired jurisdiction to adjudicate the issue therein under Revised Statutes Sec. 4915 and render judgment thereon, for the reason that,

> Tower, a co-owner of the invention and application in interference and an indispensable party, was never made a party to the suit within six months after the decision in the interference, as required by R. S. 4915.

Revised Statutes, Sec. 4915 (U. S. C., title 35, sec. 63), by which jurisdiction is conferred upon the District Court

to adjudicate the issue in a suit brought thereunder provides:

> "Sec. 4915 R. S. (U. S. C., title 35, sec. 63). Whenever a patent on application is refused by the Board of Appeals or whenever any applicant is dissatisfied with the decision of the board of interference examiners, the applicant, unless appeal has been taken to the United States Court of Customs and Patent Appeals, and such appeal is pending or has been decided, in which case no action may be brought under this section, may have remedy by bill in equity, *if filed within six months after such refusal or decision; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had,* may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim or for any part thereof, as the facts in the case may appear. * * *" (Italics supplied.)

The petitioner now offers, as his excuse for not making Tower a defendant in the suit within the time allowed therefor, that Tower was attorney for Roach in the interference in the Patent Office and *inadvertently* was not made a party to the suit.

Petition for Writ of Certiorari, page 2.

> "But because Tower had been the attorney for Roach during the proceedings in the case, both in the Patent Office and subsequently, he was *inadvertently* not made a party defendant to the action, Roach being the only defendant named in the complaint as originally filed." (Italics supplied.)

The petition states that the decision of the Circuit Court of Appeals for the Seventh Circuit is in conflict with decisions of the Circuit Courts of Appeal of other circuits and the Supreme Court of the United States on the question of jurisdiction under R. S. 4915.

But the following decisions show that its decision in the

present suit was in complete accord with the decisions in other circuits in construing and applying the law under R. S. 4915.

Circuit Court of Appeals, Third Circuit, *United States* v. *Washington Institute of Technology, Inc.*,
138 F. 2d 25; 58 USPQ 503, July 31, 1943.
47 F. Supp. 384, 55 USPQ 127, D. C. District Delaware, Sept. 8, 1942.

Circuit Court of Appeals, Second Circuit, *Nachod & United States Signal Co. Inc., et al.* v. *Automatic Signal Corp., et al.*
105 F. 2d 981, 983, July 31, 1939.

District Court, E. D. New York, *Solomon* v. *Schlicker*,
58 F. Supp. 444, Dec. 5, 1944.

District Court, D. Delaware, *Shell Development Company* v. *Universal Oil Products Co.*
61 F. Supp. 925, Aug. 7, 1945.
63 F. Supp. 476, on rehearing.

Court of Appeals, District of Columbia, *Robinson, et al.* v. *Wayne, et al.*
136 F. 2d 767, May 29, 1943.

United States Supreme Court, *Robinson, et al.* v. *Wayne, et al.*
Petition for writ of certiorari denied, 320 U. S. 764.
Rehearing denied, 320 U. S. 812.

Circuit Court of Appeals, Second Circuit, *Armstrong, et al.* v. *DeForest, et al.*,
13 F. 2d 438, July 12, 1926.

United States Supreme Court, *Armstrong, et al.* v. *DeForest, et al.*,
Petition for writ of certiorari denied, 273 U. S. 734.

These decisions in different circuits do not present any diversity of opinion upon the prerequisites to jurisdiction in a suit under R. S. 4915.

The petitioner admits, by the stipulation October 29, 1943, R. pp. 491-492, that he had knowledge, ever since the interference was declared, that Tower was a co-owner of the Roach invention and application in interference, but action was never taken to make Tower a party to the suit until after the trial before the District Court had been had and an opinion rendered in favor of petitioner.

The Revised Statutes Sec. 4915, that conferred jurisdiction upon the District Court, imposed upon Klumb, the plaintiff, the duty and obligation to make Tower a party to the suit before the statutory period expired.

Tower always remained as merely the attorney for Roach in defending the suit, and never made either a voluntary or a general appearance as a party to the suit.

II. The defendant, Tower, is a defendant in name only, and not in fact, not having been made a party to the suit by due process of law, nor having himself made either a voluntary or general appearance as a party to the suit.

The fact that Tower acted as attorney for Roach in the defense of the suit does not constitute either a voluntary or a general appearance as a party to the suit, otherwise, every attorney in defending a suit for a client would become a party thereto and be bound by the judgment therein.

Tower pleaded in the answer, section III, the failure of the complaint to comply with R. S. 4915 (Rec. page 6), and further, denied, in opposing the Klumb motion to reopen, the jurisdiction of the District Court to enter judgment in the suit.

Tower opposed being made a party defendant by a supplemental complaint after the trial, and assigned as error in the statement of points on appeal R. p. 485, points 5, 39, 40, and 41, that he was so made a party defendant contrary to the statute.

The Roach patent had to be issued in the time provided by law, or otherwise, the application would have become abandoned and the right to a patent thereon would have been lost.

United States Gypsum Co., et al., v. *Masonite Corporation, et al.*

21 F. Supp. 551, 552, (D. C. D. Del., Dec. 7, 1937.)

"* * * (2, 3) This court is without jurisdiction to restrain the Commissioner of Patents from issuing a patent upon the Mason application. The Commissioner of Patents is an agent of an executive branch of the government and his duties are prescribed by statute. 35 U. S. C. A. sec. 6. The real relief here sought is to enjoin the Masonite Corporation from paying the final fee after allowance of the Mason patent. Restraining defendants from paying the final fee is in effect restraining the Commissioner of Patents from issuing the patent. In other words, plaintiff is seeking indirectly to accomplish what it admits it cannot accomplish directly. If the Mason patent is allowed, the payment of the final fee is a legal right with which this court cannot interfere. Upon the payment of the final fee, the Commissioner is bound by statute to issue the patent. 35 U. S. C. A. sec. 41. * * *"

III. The decisions cited in the petition and argument for a writ of certiorari, do not appear to have any applicability to the question decided by the Circuit Court of Appeals on jurisdiction under R. S. 4915 in the present suit, nor any applicability to granting a writ of certiorari under the circumstances shown by the record.

The decisions, cited in the petition, which the Supreme Court of the United States reviewed on the question of validity and infringement of patents, did not involve a question of jurisdiction under R. S. 4915.

The decisions, cited in the petition, which involved the application of a statute of limitations as a defense, did not involve a question of statutory jurisdiction under R. S. 4915.

The statute of limitations is a personal defense that may be waived by the defendant, but a Court cannot confer jurisdiction upon itself of its own volition or by acquiescence of the parties.

The Courts in different circuits have not been in conflict in requiring as a prerequisite to ~~its~~ jurisdiction in suits under R. S. 4915 that the complaint be filed and adverse parties be made parties thereto within six months from the decision in the interference.

The statutory requirements in R. S. 4915 are jurisdictional and cannot be waived by voluntary or general appearance or otherwise after the prescribed time to file the complaint has passed.

Shell Development Co. v. *Universal Oil Products Co.*, 63 F. Supp. 476 (D. C. Dela., Dec. 4, 1945).

IV. The petition feigns that the electric fence industry has been localized and concentrated in the Seventh Circuit, and that the Roach patent in suit would dominate the electric fence industry.

The record on appeal shows the fact to be that the electric fence industry is distributed far and wide from the Seventh Circuit.

Among those engaged in the electric fence industry, who were parties to the interference, in addition to Roach and Klumb, as it was declared, were:

Edwin J. Parker,
Spencerport,
New York.

Alger Seltz,
R. F. D. #2, Box 155,
Harbor Beach, Michigan.
(Rec. page 503.)

The Thomas' Register of American Manufacturers, 1944, lists the following electric fence manufacturers outside the Seventh Circuit:

Richards' Electro-Fence Co.
Payette, Idaho.

Electric Fence Co., Inc.,
Indianapolis, Ind.

Fred Stein Laboratory,
Atchinson, Kansas.

Sparks-Withington Co.,
Jackson, Mich.

Landon P. Smith, Inc.,
Irvington, N. J.

Hartman Electric Mfg. Co.,
Mansfield, Ohio.

W. Haddon Judson Mfg. Co.,
Ardmore, Pa.

The record on appeal further shows the fact to be that different types of electric fence controllers, not under the Roach patent in suit, are made and sold in the electric fence industry, among which are the Gengler-~~Prince~~ PRIME Controller and the Klumb Controller. (Exhibit 5, R. p. 269, Q. 134.)

V. The respondents submit that the petition for a writ of certiorari should be denied, for the reasons that:

The decision of the Circuit Court of Appeals for the Seventh Circuit is not in conflict with decisions of the Courts of Appeal of other circuits, or of the Supreme Court of the United States on the question of jurisdiction under Revised Statutes, Sec. 4915.

The question decided by the Court of Appeals concerns only the parties to the suit, and does not concern the public at large, and it does not involve a matter of great or momentous importance to the public.

The subject matter in suit does not in any way dominate the electric fence industry.

The electric fence industry, as is shown by the record, is not localized and concentrated in the Seventh Circuit.

The statements made in petition and argument about the electric fence industry are not substantiated.

Respectfully submitted,

EDWIN B. H. TOWER, JR.,
Attorney for Respondents.

Milwaukee, Wisconsin,
February 7, 1946.